

**UNITED STATES DEPARTMENT OF COMMERCE****Pat nt and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/986,186 12/05/97 PETERSON

T 8757-009

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

HM22/0317

EXAMINER

BRUSCA, J

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

03/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**BEST AVAILABLE COPY**

# Office Action Summary

Application No.  
08/986,186

Applicant(s)

Peterson et al.

Examiner

John S. Brusca

Group Art Unit

1631



☒ Responsive to communication(s) filed on 2/10/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 27-50 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 27-50 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. The group and or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1631.

#### ***Oath/Declaration***

2. The Rule 1.63 Declaration received 2/10/00 has been entered.

#### ***Specification***

3. The request for entry of the computer readable form of parent Application No. 08/639255 received 2/1/00 has been processed and entered into the instant application.

4. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reasons:

The applicants have not submitted a Sequence Listing as set forth in 37 CFR § 1.821 (see MPEP § 2422). The request to enter the paper copy of the sequence listing of parent Application No. 08/639255 received 2/1/00 is improper because 37 CFR 1.821(e) only provides for

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incorporation of a computer readable form of a parent application, not a paper copy of the sequence listing.

Applicants are required to comply with all of the requirements of 37 CFR § 1.821 through 1.825. Any response to this office action which fails to meet all of these requirements will be considered non-responsive. The Applicant's attention is directed to the attached Notice to Comply with the Sequence Rules. The nature of the sequences disclosed in the instant application has allowed an examination on the merits, the results of which are communicated below.

***Inventorship***

5. In view of the papers filed 2/10/00, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(c). The inventorship of this application has been changed by addition of Katie A. Thompson.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 34, 35, 41, 42, 45, 47, 49, and 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for reasons of record in the Office Action mailed 8/10/99.

8. Applicant's arguments filed 2/10/00 have been fully considered but they are not persuasive. The Applicants state the claimed species of combinatorial libraries are disclosed in the instant specification, however the Applicants have failed to point to passages in the instant specification that discusses the claimed species of libraries. The Applicants have pointed to disclosure of the various antibiotics and multiple protein systems mentioned in the claims. This is not disclosure of genetic libraries that express the claimed protein systems and multiple protein systems that synthesize the claimed species of molecules. The Applicants assert that the genes encoding the claimed gene products or genes that synthesize the claimed species of molecules are well known, but have not provided documentation to support their assertion. It is further brought to the Applicant's attention that the specification does not refer to references showing the genes related to the claimed species of molecules.

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*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

10. Claims 27-34, 36-41, 43-46, and 48-50 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter for reasons of record in the Office Action mailed 8/10/99.

11. Applicant's arguments filed 2/10/00 have been fully considered but they are not persuasive. The Applicants have amended the instant application to include Katie A. Thompson as an inventor, however the cited reference U.S. Patent No. 5,824,485 includes Nicole M. Nasby as an inventor and so the reference remains that of a different entity. The Applicants have asserted in their response received 2/1/00 that Nicole M. Nasby was not an inventor of the subject matter claimed in the instant application, however such a statement must be in the form of a Declaration under 37 CFR § 1.132, see MPEP 716.01.

*Terminal Disclaimer*

12. The terminal disclaimer filed on 2/1/00 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. PATENT Nos.

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5,783,431 and 5,824,485 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Double Patenting***

13. The rejection of claims 27-29, 32-36, 39-42, and 44-49 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 and 22 of U.S. Patent No. 5,783,431 in view of Vining in the Office Action mailed 8/10/99 is withdrawn in view of the Terminal Disclaimer received 2/10/00.

14. The rejection of claims 27-29, 32-36, and 39-42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 8, and 10 of U.S. Patent No. 5,824,485 in view of Vining is withdrawn in view of the Terminal Disclaimer received 2/10/00.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Certain papers related to this application may be submitted to Art Unit 1631 by facsimile transmission. The FAX number is (703) 305-7939. In such cases please call the Examiner at (703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

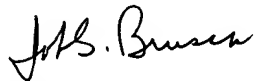


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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "J.S. Brusca".

John S. Brusca, Ph.D.

Primary Examiner

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: \_\_\_\_\_

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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